



10 DEC 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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J. Peter Fasse
Fish & Richardson, P.C.
225 Franklin Street
Boston, MA. 02110

In re Application of
SOUKOS, et al.
U.S. Application No.: 10/019,837
PCT No.: PCT/US00/13231
Int. Filing Date: 12 May 2000
Priority Date: 12 May 1999
Attorney Docket No.: 00786-421002
For: PERMEABILIZING BIOFILMS

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicant's "Petition Under 35 U.S.C. § 116 and 37 C.F.R. § 1.47(a)" filed 10 September 2002 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 12 May 2000, applicant filed international application PCT/US00/13231, which claimed priority of an earlier application filed 12 May 1999. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 12 November 2001.

On 09 November 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1). An oath or declaration of the inventors was not included.

On 12 March 2002, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International Application number and international filing date. Applicant was further advised of the need to provide payment of the surcharge for providing an executed oath or declaration of the inventors later than thirty months from the priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 10 September 2002, applicant responded with the present petition to accept the present oath or declaration without the signature of joint inventor Shun Lee accompanied by a check in the amount of \$130.00 for the petition fee for a petition under 37 CFR 1.47(a); a check

in the amount of \$65.00 as payment of the surcharge for providing an executed oath or declaration of the inventors later than thirty months from the priority date) and a check in the amount of \$720.00 as payment of the four-month extension of time fee; a petition for a four-month extension of time, and a declaration executed by joint inventors Nikolaos S. Soukos and Apostolos G. Doukas. With the filing of the petition for a four-month extension of time and payment of fee, applicant's petition is considered to be timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. With the filing of the present petition and accompanying papers, applicant has satisfied all four items and it is appropriate to grant the petition under 37 CFR 1.47(a).

Regarding item (1), applicant has provided payment of the appropriate petition fee.

As to item (2), 35 U.S.C. 4 precludes officers and employees of the USPTO from applying for a patent and from acquiring, directly or indirectly, except by inheritance or bequest, any patent or any interest in any patent, issued or to be issued by the USPTO. As such, the filed declaration of counsel detailing Dr. Lee's refusal to execute the combined declaration and power of attorney satisfies item (2) above.

Regarding item (3), applicant has supplied a statement of the last known address of Dr. Lee.

As to item (4), applicant has a combined declaration and power of attorney executed by joint inventors Nikolaos S. Soukos and Apostolos G. Doukas on their own behalf and on behalf of Dr. Lee.

Accordingly, applicant has satisfied all four items detailed above and it is proper to grant applicant's petition at this time.

CONCLUSION

For the reasons above, the petition is **GRANTED**.

The application has an international filing date of 12 May 2000 under 35 U.S.C. 363, and will be given a date of **10 September 2002** under 35 U.S.C. 371 (c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded

to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



Richard Cole
Legal Examiner
PCT Legal Office



Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459



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Dr. Shun Lee
1600 S. Eads Street, Apt. 617S
Arlington, VA. 22202

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Dear Dr. Lee:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Richard Cole
Legal Examiner
PCT Legal Office

Derek A. Putonen
Attorney Advisor
PCT Legal Office

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